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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,647	10/10/2000	Jeffrey M. Friedman	600-1-087CIP/DIV/COM	6790

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EXAMINER

MARVICH, MARIA

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 04/22/2003

124

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,647

Applicant(s)

FRIEDMAN ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

This office action is in response to an amendment filed 2/6/03. Claims 1-58 have been canceled.

Claims 59-65 are pending in this application.

Response to Petition

A petition filed on February 1, 2001, paper # 3, was filed in response to a Notice of Omission regarding the lack of figure 3 from the specification filed October 10, 2000. This petition was dismissed with a recommendation that figure 3 be filed as a preliminary amendment. Figure 3 has been subsequently filed with a new set of drawings that were filed 2/6/03 in response to drawing corrections requested in the office action filed on 7/30/02. Figure 3 is the amino acid sequence of the human ob protein. This sequence has also been provided in the specification as SEQ ID No. 4 and has been deduced from SEQ ID No 3 (figure 2). Figure 3 therefore does not present New Matter.

Response to Amendment

Receipt of formal drawings is acknowledged.

The objection to figures 8, 11A and 12A is withdrawn in light of the newly submitted figures.

The objection to the abstract because it exceeds the 250 words limit is withdrawn in light of submitted abstract.

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The objection to the specification under 37 CFR 1.821(a)(1) and (a)(2) as containing a sequence listing disclosed on page 76 that does not have a SEQ. ID No. associated with it is withdrawn due to the amendment to the specification to enter the SEQ. ID No.

The rejection of claims under 112, first paragraph, has been withdrawn in light of applicants arguments. Specifically, applicant argues that the specification, particularly through figure 4 and 5, teaches non-conservative amino acid changes in SEQ ID No. 2, 4, 5 and 6. The non-conservative amino acid changes are demonstrated through for example an alignment of SEQ ID No. 2 and 4 in which there are 19 non-conservative amino acid substitutions between the two. Furthermore, written description for OB polypeptides that read on N-terminal methionine as well as N-terminal polyaminoacid is clarified.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 59, 60 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, 6 and 8 of U.S. Patent No. 6,429,290 (effective filing date 8/17/1994). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claims because the examined claim is either anticipated by, or would have been obvious over, the reference claims. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the instant invention is generic to all that is recited in the cited claims of U.S. Patent No. 6,429,290. Specifically, U.S. Patent No. 6,429,290 claims an OB polypeptide comprising the amino acid sequence set out in amino acids 22-167 of SEQ ID No: 2 and SEQ ID No: 4 or amino acids 22-166 of SEQ ID No: 5 and SEQ ID No: 6. Either the group consisting of SEQ ID No. 2 and 4 or consisting of SEQ ID No. 5 and 6 differ from one another by a non-conservative amino acid substitution.

Additionally, if a patent resulting from the instant claims was issued and transferred to an assignee different from the assignee holding the 6,429,290 patent, then two different assignees would hold a patent to the claimed invention of 6,429,290, patent and thus improperly there would be possible harassment by multiple assignees. **This is a new rejection necessitated by applicant's amendment.**

Claims 59, 60 and 63-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 7, 9, 10 and 15 of U.S. Patent No. 6,471,956 (effective filing date 8/17/1994). An obviousness-type double patenting rejection is

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appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claims because the examined claim is either anticipated by, or would have been obvious over, the reference claims. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the instant invention is generic to all that is recited in the cited claims of U.S. Patent No. 6,471,956. Specifically, U.S. Patent No. 6,471,956 claims an OB polypeptide comprising the amino acid sequence set out in amino acids 22-167 of SEQ ID No: 4 or SEQ ID No: 6 with several non-conservative amino acid substitutions (i.e. serine with alanine or arginine with glutamine). As well, U.S. Patent No. 6,471,956 claims the chemically synthesized or recombinant OB polypeptides that correspond to the previously cited OB polypeptides.

Additionally, if a patent resulting from the instant claims was issued and transferred to an assignee different from the assignee holding the 6,471,956 patent, then two different assignees would hold a patent to the claimed invention of 6,471,956, and thus improperly there would be possible harassment by multiple assignees. **This is a new rejection necessitated by applicant's amendment.**

No Claims are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maria B Marvich, PhD
Examiner
Art Unit 1636

April 18, 2003



**JAMES KETTER
PRIMARY EXAMINER**